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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/741,265 10/30/96 SINGH

H 11611.4US01

LM02/0504

EXAMINER

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YAO, K

ART UNIT	PAPER NUMBER
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2731 11

DATE MAILED:

05/04/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/741,265	Applicant(s) Singh
	Examiner Kwang B. Yao	Group Art Unit 2731

Responsive to communication(s) filed on _____.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) 13-15 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-12 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to an arrangement and a method for providing telephonic communication using Internet communication protocols, classified in class 370, subclass 389.
 - II. Claims 13-15, drawn to an Internet telephone housing, classified in class 379, subclass 428.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are that Group I directs to an arrangement for data communication using Internet protocol, while Group II directs to an arrangement for Internet phone housing.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Robert J. Crawford on 4/12/99 a provisional election was made with traverse to prosecute the invention of I, claims 1-12. Affirmation of this

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election must be made by applicant in replying to this Office action. Claims 13-15 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

6. The information disclosure statement filed 6/29/98 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

7. The disclosure is objected to because of the following informalities: the copending application serial number is missing on page 7.

Appropriate correction is required.

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Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claim 1 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Noonan et al.

(US 5,761,280).

Noonen et al. disclose a telephone WEB browser arrangement depicted in Fig. 1 comprising: a telephone 24; an interface unit 10 for receiving information from telephone 10 (an interface unit coupled to the telephone and configured and arranged to receive audio information of the telephonic communication); interface unit 10 for connecting with either PSTN network or the Internet (a first output port configured to be coupled to a standard switched telephone communication network, a second output port configured to be coupled to an Internet communications network); in step 44 of Fig. 7, a decision for determining whether a received DTMF code representing a request for Internet access or PSTN communication (a processing unit). (See columns 2-3 and 7).

Claim Rejections - 35 USC § 103

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 2-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noonan et al. (US 5,761,280).

Noonen et al. disclose the claimed limitations discussed above. Noonan et al. do not disclose the features of specific protocols, such as the claimed RAS, Q.931, H.24, RTCP. However, Examiner hereby taking the official notice that these features are so well known in the art and well within the level of skilled artisan to implement in the arrangement of Noonan et al. as design choice based upon the arrangement specification and requirement for users.

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Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bashoura et al. (US 5,862,202) discloses a FAX routing system.

Andrews et al. (US 5,848,143) discloses a communication systems.

Kahn et al. (US 5,838,665) discloses a data network telephone adaptor device.

Carmello et al. (US 5,809,118) discloses a system for triggering actions.

Krane (US 5,799,063) discloses a communication system.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwang B. Yao whose telephone number is (703) 308-7583. The examiner can normally be reached on Monday through Friday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703) 305-4378.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

14. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

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(703) 305-9051, (for formal communications intended for entry)

Or:

(703) 305-3988 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

Kwang B. Yao

April 28, 1999



CHI H. PHAM
SUPERVISORY PATENT EXAMINER
GROUP 2700 4/30/99